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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/870,188      | 05/30/2001  | Frederick Lee Kitson | 10005869            | 7283             |

7590 11/23/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT PAPER NUMBER

2635

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/870,188

Applicant(s)

KITSON ET AL.

Examiner

Brian A Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-29 and 40-43 is/are allowed.
- 6) ☒ Claim(s) 30-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **EXAMINER'S RESPONSE**

### **Status of Application**

In response to the applicant's amendment received on 10/5/04. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 30-39 are unpatentable for the reasons set forth in this office action:

### ***Allowable Subject Matter***

1. Claims 8-29,40-43 are allowed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

2. Claims 30-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Russell (2004/0044627).

Russell shows a method for authenticating, such that baseline samples are gathered over time to accurately represent minor changes in the biometric

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that occur over time, see paragraph 190. New biometrics are gathered and added to the baseline profile for the individual to update the profile. The updated profile is then used for authentication and authorization functions. Since the profile is not updated each and every time the system is used, there are periods of time when the profile is frozen. Paragraph 39 discusses the method being performed by a portable device. Paragraph 209 discusses the biometric being a person's iris or voice. Regarding claim 35, it is assumed that an image of a person's iris is the same as an image of a person's face. For claim 30, it is assumed that online purchasing is one of the user's normal activities.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell as applied to claim 35 above, and further in view of the admitted prior art discussed by the applicant in the present specification (hereafter APA).

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In the above 102 rejection, it is assumed that an image of a person's iris is the same as an image of a person's face, if this is not the case based upon a differing interpretation of the claims), the following rejection is offered. The applicant admits on paragraph 5, that the use of a person's face is a well known technique in providing biometric authentication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an image of the user's face as the biometric element in the Russell authentication system since this would be another biometric equivalent to those discussed by Russell for biometric authentication systems.

### ***Response to Arguments***

Applicant's arguments with respect to the rejected have been considered but are moot in view of the new ground(s) of rejection.

The disagreement over the interpretation of the term "normal activities" remains. The applicant argues that the term must be interpreted in light of the specification, while this is correct; it is not permissible to import meanings into the claims that are not present. The applicant points to a section of the specification that gives examples of normal activities. These are merely examples and do not provide an explicit definition of the term "normal activities". Without a specific definition of the term in the specification, definition is determined by the normal meaning (in the art). This is not as the applicant argues the term. The applicant attempts to define the term using the examples, which is fine if there were

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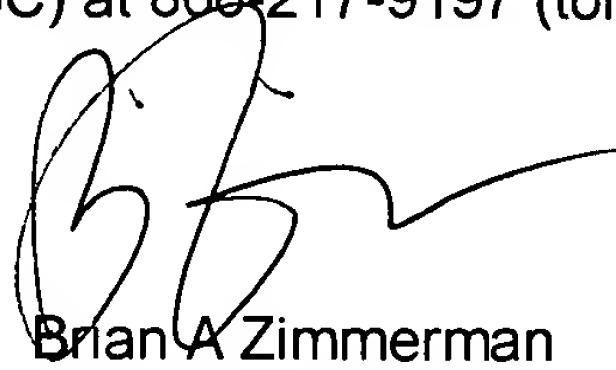
enough examples to draw a conclusion. The applicant's line of reasoning is that since none of the examples includes a person attempting to authenticate themselves the definition must mean any activity that is not an authentication activity. This reasoning is flawed. The examples given do not include walking, eating, sleeping or breathing. Following the applicant's reasoning then these would not be "normal activities"; this cannot be further from the truth. These examples are normal activities, as one of ordinary skill in the art would infer from reading the specification. If the applicant continues this interpretation of the term, a 35 USC 112 second paragraph rejection will be considered since it would be near impossible to determine the scope of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A Zimmerman  
Primary Examiner  
Art Unit 2635

BAZ